

REMARKS

Fifty-two claims are currently pending in the present Application. Claims 1-52 currently stand rejected under 35 U.S.C. 103(a). In addition, the Examiner objects to the Specification and to claim 22. Accordingly, claim 22 is amended herein. Reconsideration of the Application in view of the foregoing amendment and the following remarks is respectfully requested.

Specification

On page 2 of the Office Action, the Examiner states that “[t]he specification is objected to as failing to provide proper antecedent basis for the claimed subject matter.” In particular, the Examiner further states that “Claim 41 mentions a computer readable medium, but the specification does not provide an example for what a medium can be.” Applicants respectfully traverse.

Applicants submit that the Specification provides ample description for “what a medium can be.” For example, Figures 4 and 5 provide specific examples for one embodiment of a computer readable medium.” In addition, on page 10, lines 27-30, the Applicants expressly describe the computer readable medium by stating that “*memory 220 may be implemented to include any combination of desired storage devices, including, but not limited to, read-only memory (ROM), random-access memory (RAM), and various types of non-volatile memory, such as floppy disks, memory sticks, compact disks, or hard disks.*”

For at least the foregoing reasons, Applicants submit that the Specification expressly provides affirmative support for “what a medium can be.” Applicants

therefore respectfully request the Examiner to reconsider and withdraw the objection to the Specification.

Claim Objection

On page 2 of the Office Action, the Examiner objects to dependent claim 22 for certain "informalities." In particular, the Examiner states that "[c]laim 22 is apparently supposed to be dependent on claim 21 not claim 1. Accordingly, Applicants herein amend claim 22 to claim dependency upon independent claim 21 instead of independent claim 1. Applicants therefore respectfully request the Examiner to expressly withdraw the objection to claim 22, so that this claim may issue in a timely manner.

35 U.S.C. § 103

On page 2 of the Office Action, the Examiner rejects claims 1-52 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. US2004/0201709 to McIntyre et al. (hereafter McIntyre). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine

reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations" (emphasis added).

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness because the single cited reference to McIntyre fails to teach "all the claim limitations."

On page 3 of the Office Action, with regard to claims 1, 21, 41-47, and 52, the Examiner expressly concedes that the single cited reference to McIntyre "fails to disclose that said target photo manager automatically storing said photo data into a target photo album." Applicant concur. Then, without providing any specific additional references to support the rejections of the claimed limitations that are missing from McIntyre, the Examiner cursorily concludes that "it would have been obvious to include a photo album" Applicants respectfully traverse.

It appears that the Examiner is tacitly utilizing Official Notice without expressly stating so. Applicants submit that the particular combination of claimed limitations would not be obvious to one skilled in the art at the time of the invention. Applicants further submit that the Examiner has improperly utilized Official Notice because the cited limitations are uniquely utilized by the Applicants to produce novel combinations that are not well-known. Applicants therefore respectfully request the Examiner to cite specific references in support

of these rejections, and failing to do so, to reconsider and withdraw the rejections of claims 1-52 so that the present Application may issue in a timely manner.

Furthermore, the Court of Appeals for the Federal Circuit has held that “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination.” In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Applicants submit that there is no teaching of a combination that would result in Applicants’ invention, and therefore the obviousness rejections under 35 U.S.C §103 are not proper.

Applicants submit that the cited reference, in combination with the Official Notice, do not suggest a combination that would result in Applicants’ invention. Applicants therefore respectfully request the Examiner to issue a new Non-Final Office Action that cites specific additional references in support of the Official Notice, and to also indicate where an explicit teaching to combine the cited references may be found. Alternately, the Applicants request that the Examiner reconsider and withdraw the rejections of claims 1-52 under 35 U.S.C §103.

With further regard to the rejections of the pending independent claims, Applicants submit that independent claims 1, 21, 41-43, 45, 47, and 52 also recite other additional limitations that are not taught or suggested either by the solitary cited reference of McIntyre, or by the Examiner’s citations thereto. McIntyre essentially teaches an “electronic camera 23” that downloads captured images through a “service provider 80” to the camera user’s “computer 10” (see FIG. 15).

However, in independent claims 1 and 21, Applicants expressly claim a “target device” that is uniquely configured for “automatically detecting” the receipt of a “photo message” from a “source device,” and “automatically storing said photo data into a target photo album” (emphasis added) without direct intervention by a target device user. Applicants submit that McIntyre nowhere teaches or suggests any techniques for “automatically” detecting and populating an electronic photo album on a target device.

Furthermore, Applicants submit that McIntyre fails to teach a source device for “automatically creating a photo message that includes said photo data and photo identifier means to request a special handling of said photo data” so that the target device can automatically detect the “photo identifier means” and “automatically” populate the “target photo album” (emphasis added). In particular, Applicants submit that McIntyre fails to disclose the “photo identifier means” that is disclosed and claimed by Applicants.

On page 3 of the Office Action, the Examiner apparently attempts to analogize Applicants’ “photo identifier means” to the “image icon” that is disclosed by McIntyre. Applicants respectfully traverse. In McIntyre, the “image icon” of FIG. 10 is described to only perform the narrow function of identifying a person whose face is “depicted in the captured images” (see paragraph 0098). McIntyre also refers to the image icon as a “content identifier” that only identifies the person whose image is contained in a corresponding photograph (see paragraph 0100) and FIG. 10b.

In contrast, Applicants disclose and claim “photo identifier means” that identify the fact that a given “photo message” is intended for automatic insertion into a “target photo album.” Applicants’ claimed “photo identifier means” does not specifically identify the subject of a given photograph, as in McIntyre. Applicants therefore submit that both the purpose and the implementation of their “photo identifier means” are significantly different from that of the “image icon” that is disclosed by McIntyre.

In addition, the Examiner repeatedly cites paragraph 0100 of McIntyre against various limitations recited by Applicants. For example, paragraph 0100 of McIntyre discusses the utilization of a single “camera 23” from the embodiment of FIG. 15 for both capturing image data, and for also transmitting the captured image data to a target destination. The “camera 23” of McIntyre is therefore implemented to perform two different functions within the same physical device. In contrast, in independent claims 1 and 21, Applicants affirmatively recite a discrete “photo data source” and a separate “source device” as distinct and individual entities. Applicant therefore respectfully submit that the single unitary “camera 23” shown in FIG. 15 of McIntyre cannot accurately be analogized to the two different claimed elements (“photo data source” and “source device”) that are specifically recited by Applicants as separate entities.

With regard to claim 42, “means-plus-function” language is utilized to recite elements and functionality similar to those recited in claims 1 and 21 as discussed above. Applicants therefore incorporate those remarks by reference with regard to claim 42. In addition, the Courts have frequently held that

“means-plus-function” language, such as that of claim 42, should be construed in light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof. Applicants respectfully submit that, in light of the substantial differences between the teachings of McIntyre and Applicants’ invention as disclosed in the Specification, claim 42 is therefore not anticipated or made obvious by the teachings of McIntyre.

Regarding the Examiner’s rejection of dependent claims 2-20, 22-40, 44, 46, and 48-51, for at least the reasons that these claims are dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 2-20, 22-40, 44, 46, and 48-51, so that these claims may issue in a timely manner.

With further regard to the rejections of claims 5 and 25, on page 4 of the Office Action, the Examiner concedes that McIntyre “does not expressly disclose a electronic gaming programs (sic).” Applicant concur. Then, without providing any specific additional references to support the rejections of the claimed limitations that are missing from McIntyre, the Examiner cursorily concludes that “it would have been obvious to one of ordinary skill in the art” Applicants respectfully traverse.

It appears that the Examiner is again tacitly utilizing Official Notice without expressly stating so. Applicants submit that the particular combination of claimed limitations would not be obvious to one skilled in the art at the time of the invention. Applicants further submit that the Examiner has improperly utilized Official Notice because the cited limitations are uniquely utilized by the Applicants to produce novel combinations that are not well-known. Applicants therefore respectfully request the Examiner to cite specific references in support of these rejections, and failing to do so, to reconsider and withdraw the rejections of claims 5 and 25 so that the present Application may issue in a timely manner.

Regarding the rejections of dependent claims 6 and 26, Applicants submit that McIntyre fails to teach automatically creating “a special photo identifier tag that said source mail program creates as part of a message header of said photo message to thereby identify said photo message as containing said photo data for automatically storing into said target photo album” as disclosed and claimed by Applicants. On page 4 of the Office Action, the Examiner apparently attempts to analogize Applicants’ “photo identifier tag” to the “image icon” that is disclosed by McIntyre. Applicants respectfully traverse.

In McIntyre, the “image icon” of FIG. 10 is described to only perform the narrow function of identifying a person whose face is “depicted in the captured images” (see paragraph 0098). McIntyre also refers to the image icon as a “content identifier” that only identifies the person whose image is contained in a corresponding photograph (see paragraph 0100) and FIG. 10b. In contrast, Applicants disclose and claim the photo identifier tag specifically “*to thereby*

identify said photo message as containing said photo data for automatically storing into said target photo album” (emphasis added).

In addition, Applicants submit that McIntyre nowhere discloses utilizing any sort of “message header,” as expressly claimed by Applicants. Applicants therefore submit that both the purpose and the implementation of their “photo identifier tag” are significantly different from that of the “image icon” that is disclosed by McIntyre. For at least the foregoing reasons, Applicants therefore submit that claims 6 and 26 are not unpatentable in light of the cited reference. Applicants therefore respectfully request reconsideration of the rejections of claims 6 and 26.

Regarding the rejections of dependent claims 11-12 and 31-32, Applicants submit that McIntyre nowhere teaches “*a streamlined one-click transmission procedure in which said source photo manager captures said photo data from said photo data source, said source photo manager then automatically sending said photo data to said source mail program,” followed by “said source mail program then automatically transmitting said photo message,” as disclosed and claimed by Applicants.*

In particular, Applicants submit that McIntyre fails to disclose an efficient and user-friendly technique for “automatically” capturing, formatting, and transmitting photo data to populate a target electronic photo album in response to a single “one-click” triggering action performed by a device user of the source device. For at least the foregoing reasons, Applicants submit that claims 11-12 and 31-32 are not unpatentable in light of the cited reference. Applicants

therefore respectfully request reconsideration of the rejections of claims 11-12 and 31-32.

With regard to the rejections of claims 17 and 37, on page 6 of the Office Action, the Examiner concedes that McIntyre “does not disclose a header per se.” Applicant concur. Then, without providing any specific additional references to support the rejections of the claimed limitations that are missing from McIntyre, the Examiner cursorily concludes that “it would have been obvious” Applicants respectfully traverse.

It appears that the Examiner is again tacitly utilizing Official Notice. Applicants submit that the particular combination of claimed limitations would not be obvious to one skilled in the art at the time of the invention. Applicants further submit that the Examiner has improperly utilized Official Notice because the cited limitations are uniquely utilized by the Applicants to produce novel combinations that are not well-known. Applicants therefore respectfully request the Examiner to cite specific references in support of these rejections, and failing to do so, to reconsider and withdraw the rejections of claims 17 and 37 so that these claims may issue in a timely manner.

Examiner Interview Summary

On July 3, 2007, Applicants' representative, Gregory Koerner, held an Examiner's Interview with Examiner Philip Chea to discuss various differences between the cited references and Applicants' claimed invention. With respect to the Examiner's objection to the Specification, Applicants argued that multiple specific examples of their claimed "computer-readable medium" may readily be found in the Specification, for example, on page 10, lines 27-30.

With regard to the rejections of claims 1-52 under 35 U.S.C. 103, Applicants argued that the Examiner has not established a prima facie case by providing references covering "all claimed limitations," as required by MPEP 2142. With more specific reference to the independent claims, the Examiner concedes that the cited reference fails to disclose "automatically disclosing said photo data into a target photo album." With further regard to dependent claims 17 and 37, the Examiner concedes that the cited reference fails to disclose decoding "a message header of said photo message." For at least the foregoing reasons, Applicants therefore submitted that the Examiner is tacitly utilizing Official Notice.

Applicants also argued that a number of the dependent claims contain various limitations that are not taught by the cited reference. For example, Applicants submit that McIntyre nowhere teaches a "photo identifier tag" that is utilized by both a source device and a target device to automatically "identify said photo message as containing said photo data," as specifically recited by Applicants in dependent claims 6, 18, 26, and 38. Furthermore, Applicants

argued that the cited reference fails to teach the “one-click transmission procedure,” as recited in claims 11 and 31.

Summary

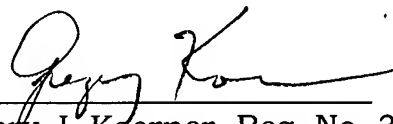
Applicants submit that the foregoing amendment and remarks overcome the Examiner's objections and rejections under 35 U.S.C. §103(a). Because the cited reference, and the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-52, so that the present Application may issue in a timely manner. If there are any questions concerning this Response, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,

Date: _____

8/3/07

By: _____



Gregory J. Keerner, Reg. No. 38,519
Redwood Patent Law
1291 East Hillsdale Blvd., Suite 205
Foster City, CA 94404
Tel: (650) 358-4000